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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/594,408

Applicant(s)

ERICKSON ET AL.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This case has been reassigned to a new examiner.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/15/2005 has been entered.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

4. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.
5. The disclosure is objected to because of the following informalities:

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6. All pending applications should be updated periodically to conform to their current status within the Office. Applicant is asked to verify the status of all co-pending applications listed within the disclosure and update as necessary.

7. Applicant's use of descriptive numbers within the disclosure is confusing to one of ordinary skill in the art. The Examiner points to page 18 of the disclosure as a specific example where the item numbers have become confused with the text of the disclosure. Applicant is required to make any necessary punctuation changes to eliminate the confusion that exists in this regard.

8. The use of the trademarks Microsoft, ActiveX, Oracle, visual basic, et al. has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

Claim Objections

9. Claims 9 and 10 are objected to because they are dependent upon themselves. Because the Examiner is unable to ascertain with reasonable certainty what claims 9 and 10 depend from, they have not been treated with art rejections. However, 112 rejections have been made against the aforementioned claims for purposes of compact prosecution.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 5, 9, 14, 15 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner cannot find within the disclosure a reasonable explanation of how a service request can comprise C++, how a format can comprise an active server page, how a service request can comprise an Active Server Page, or how a protocol can comprise Visual Basic. Such claimed items are programming languages, and Applicant has claimed that these formats, requests, and protocols can comprise programming languages without giving one of ordinary skill in the art a reasonable amount of knowledge to grasp the intended process necessary to make these conversions. Claims 5, 9, 14-15 and 20 cannot be treated by the Examiner in this Office Action with an art rejection because no relevant art would be able to be located on the basis that Visual Basic is not a protocol (claim 5), an Active Server page is not a service request (claim 9), an active server page is not a format (claim 14), a standard programming language is not a format (claim 15), and C++ is not a service request (claim 20).

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-8, 11, 13-14, 16, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. In regard to claims 1-2, 5-6, and 10, the Examiner is unclear from the claims and specification whether a *terminal* is hardware or software based. In regard to claims 1, 4, 6-7, 11, and 14, the Examiner is unclear whether a *server* is hardware or software based. In regard to claims 1, 7, 11, and 16, the Examiner is unclear whether the *adapter* claimed is hardware or software based. The Examiner cannot

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grasp what Applicant's claimed invention is upon referring to the claims in light of the specification, based on the use of *terminal*, *server*, and *adapter*, which are commonly utilized terms in the art that can be applied to both hardware and software. The specification seems to be directed to a software definition of these terms, but the claims seem to be directed towards a hardware definition of these terms.

15. In regard to claim 1, the Examiner is unclear what the difference is between *one of said plurality of protocols* and *an enterprise protocol*. In regard to claim 4, the Examiner is unclear what Applicant means by *an Industry Standard Server*. In regard to claim 5, the Examiner is unclear on what Applicant means by *an industry compatible personal computer*.

16. Claim 5 is rejected as being indefinite because of the use of the trademark Visual Basic. Applicant must give the generic equivalent of this terminology.

17. The term "responsibly coupled" in claim 6 is a relative term which renders the claim indefinite. The term "responsibly coupled" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

18. The term "publicly accessible" in claims 1, 3, 6, 7, 8, 11, 13, 16, and 19 is a relative term which renders the claim indefinite. The term "publicly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

19. Claims 1-5 recite the limitation "the improvement" in the preamble. There is insufficient antecedent basis for this limitation in the claim. The Examiner is further unclear what Applicant is improving in the preamble.

Claim Rejections - 35 USC § 101

20. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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21. Claims 1-10 and 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-10 and 16-20 seem to be directed to software *per se*, and not towards any embodiment of hardware.

Claim Rejections - 35 USC § 102

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

23. Claims 1-3, 6-7, 11-13 and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Holmes (U.S. Patent No. 5,790,809).

24. In regard to claim 1, Holmes discloses *a first user terminal for entering a first transaction request, wherein said first transaction request has a first one of a plurality of protocols* (Holmes, column 3, lines 15-21), *responsively coupled via a publicly available digital communication network to an enterprise server for responding to said first transaction request using an enterprise protocol which is not one of said plurality of protocols* (Holmes, column 3, lines 7-17, lines 28-38) *the improvement comprising: a. a second user terminal for entering a second transaction request wherein said second transaction request has a second one of said plurality of protocols which is different from said first one of said plurality of protocols responsively coupled to said enterprise server via said publicly available digital communication network; and b. a generic gateway interposed between said first user terminal and said enterprise server and between said second user terminal and said enterprise server which responsively couples said first user terminal and said second user terminal to said enterprise server by converting said first one and said second one of said plurality of protocols to said enterprise protocol.* Applicant has claims a system that changes a protocol to another protocol for transmission over a network and then converts it to a third protocol for delivery. Holmes, column 3, discloses using a Registry program to accept requests under a

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protocol for a client application, encapsulating them and converting into a proprietary protocol, and delivering to the server application by converting from the proprietary protocol to a message recognizable to the server application. The process works in reverse for sending a message from the server to the client. See Holmes, column 3, lines 6-48.

25. In regard to claim 2, Holmes is applied as in claim 1. Holmes further discloses *a plurality of adapters interposed between said generic gateway and said first user terminal and said second user terminal which responsively couples said first user terminal to said generic gateway via a first one of said plurality of adapters which corresponds to said first one of said plurality of protocols and which responsively couples said second user terminal to said generic gateway via a second one of said plurality of adapters which corresponds to said second one of said plurality of protocols*. Each transmission on a network would inherently be send using a port in affiliation with a particular protocol, based on basic TCP/IP theory. Using a port would be using an adapter.

26. In regard to claim 3, Holmes is applied as in claim 2. Holmes further discloses *said publicly available digital communication network further comprises the internet*. See Holmes, column 4, lines 5-10.

27. In regard to claim 6, Holmes discloses *a. A first user terminal which generates a first service request and an associated input view file using a first one of a plurality of protocols, b. A second user terminal which generates a second service request and an associated input view file using a second one of said plurality of protocols wherein said second one of said plurality of protocols is different from and incompatible with said first one of said plurality of protocols, c. A publicly accessible digital data communication network responsively coupled to said first user terminal and said second user terminal; d. A generic gateway within a server responsibly coupled to said publicly available digital data communication network which converts said first service request and said second service request into an enterprise protocol which is not one of said plurality of protocols; and e. An enterprise server which responds to said enterprise protocol responsively coupled to said generic server*. The limitations of claim 6 are substantially the same as the limitations of claim 1. The request messages generated in column 3,

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lines 17-18 of Holmes are the *generated service request and an associated input view file*. The rejection of claim 1 is applied against claim 6.

28. In regard to claim 7, Holmes is applied as in claim 6. Holmes further discloses *A plurality of adapters responsively coupled intermediate said publicly available digital data communication network and said generic gateway*. Each transmission on a network would inherently be send using a port in affiliation with a particular protocol, based on basic TCP/IP theory. Using a port would be using an adapter.

29. In regard to claim 11, Holmes discloses *a. Composing a first service request having a first input view file using a first of a plurality of formats; b. Composing a second service request having a second input view file using a second of said plurality of formats; c. Transferring said first service request via a publicly accessible digital data communication network to a first one of a plurality of adapters corresponding to said first of said plurality of formats and said second service request via said publicly accessible digital data communication network to a second one of a plurality of adapters corresponding to said second of said plurality of formats; and d. Converting said first service request and said second service request into a standardized format for processing within a generic gateway within a server*. The limitations of this claim are substantially the same as the limitations of claims 1 and 6. The rejections of claims 1 and 6 are applied against claim 11.

30. In regard to claim 12, Holmes is applied as in claim 11. Holmes further discloses *Transferring said converted and processed first service request and second service request from said generic gateway to an end service provider*. Holmes, column 3, discloses transmitting service requests over a network to a recipient after converting the request.

31. In regard to claim 13, Holmes is applied as in claim 12. Holmes further discloses *said publicly accessible digital data communication network further comprises the Internet*. See Holmes, column 4, lines 5-10.

32. In regard to claim 16, Holmes discloses *a. first generating means for generating a first service request using a first one of a plurality of protocols; b. second generating means for generating a second service request and different one of a plurality of protocols; c. transferring means responsively coupled to*

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said generating means for transferring said first service request and said second service request via a publicly accessible digital data network; d. adapting means responsively coupled to said publicly accessible digital data network for adapting said first service request and said second service request to a standardized protocol using a different one of a plurality of adapters to convert said first service request and said second service request; and e. processing means responsively coupled to said adapting means for processing said first service request and said second service request via a generic gateway. The limitations of claim 16 are substantially the same as the limitations of claim 1. The rejection of claim 1 is used against claim 16.

33. In regard to claim 17, Holmes is applied as in claim 16. Holmes further discloses *means responsively coupled to said processing means for transferring said first service request and said second service request to an end service provider via a plurality of connectors.* Holmes accepts data and converts it between protocols during delivery of the message. See Holmes, column 3. In regard to claim 18, Holmes as applied in claim 17 further discloses *wherein said one of said plurality of adapters corresponds to said one of said plurality of connectors.* The limitations of claims 17-18 are substantially the same as the limitations of claim 2. The rejection of claim 2 is applied against claims 17-18.

34. In regard to claim 19, Holmes is applied as in claim 18. Holmes further discloses *said publicly accessible digital data communication network is the Internet.* See Holmes, column 4, lines 5-10.

Claim Rejections - 35 USC § 103

35. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

36. Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes.

37. In regard to claim 4, Holmes has taught the services of a *generic gateway* and teaches a middleware environment as shown in the rejections of claims 1 and in Holmes, column 4, lines 1-10.

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Holmes has not specifically stated that these elements were present in an Industry Standard Server housing. However, it is well known to one of ordinary skill in the art that computer parts are highly interchangeable. It would have been obvious to one of ordinary skill in the art to put any portion or combination of the elements in the Holmes invention in any type of housing, including an "Industry Standard Server" housing, in order to fit the space and power requirements of the elements in question.

38. In regard to claim 8, Holmes has taught the use of a TCP/IP network (column 4, lines 1-10), but has failed to explicitly disclose use of the world wide web. One of ordinary skill in the art at the time of the invention would know that a world wide web would require a TCP/IP network to function. The use of the world wide web was well known at the time of the invention. It would have been obvious to one of ordinary skill in the art to use Holmes with any type of TCP/IP network, including with the world wide web.

Double Patenting

39. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

40. Claims 1, 6, 11 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,233,619, also issued to the Assignee. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations are substantially the same.

41. Claim 1 of the Narisi patent describes an interconnection coupling between heterogeneous computer systems that works in the background to provide a general purpose transport environment which is transparent to the first and second network applications. This is equivalent to converting differing

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protocols to a generic enterprise protocol for network transport as claimed in claims 1, 6, 11 and 16 of the instant application.

Response to Arguments

42. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 571-272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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